

REMARKS

This is in response to the Office Action, Paper No./Mail Date 20060904, mailed on September 19, 2006. Applicant has carefully studied the references cited by the Examiner and the Examiner's comments relative thereto.

Claims 4, 5, 6, 7, 8, 9, 12, and 13 have been amended.

Claims 10, 11, 67, and 68 are currently withdrawn.

New Claims 79 and 80 have been added to claim subject matter Applicant is entitled to claim.

Claims 1-16, and 59-80, inclusive, are pending in the application.

Figs. 14-21 have been corrected responsive to the Notice of Draftsperson's Patent Drawing Review.

No new matter has been added.

Reconsideration of the application, as amended, is respectfully requested.

Claims 4-9, 12, and 13, inclusive were amended to change the dependency thereof and make minor corrections associated therewith.

Claims 10, 11, 67, and 68 were withdrawn as nonelected species claims, which may be allowed pending allowance of a generic or linking claim. Claim 4 is identified by Applicant as a generic claim for Claims 10 and 11. This is in agreement with a statement of the Examiner in an Office Action dated May 9, 2006. Claim 59 is also identified by Applicant as a generic or linking claim for Claims 67 and 68.

The Examiner objected to Figs. 14-21 of the Drawings under 37 C.F.R. § 1.84(l) and (p). Responsive to the requirement of the Examiner, Applicant has corrected the drawings. A substitute set of nine (9) drawing sheets containing Figs. 14-21 is included, and a Letter to the Official Draftsman is filed concurrently herewith.

In view of the filing of the corrected drawing sheets including Figs. 14-21, withdrawal of the objection of the drawings under 37 C.F.R. § 1.84(l) and (p) by the Examiner is respectfully requested.

The Examiner rejected Claims 6 and 8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated:

The claims describe "connecting the database to a host computer, connecting a remote terminal to the host computer, sending a selected one of the unique identifying indicia from the remote terminal to the host computer and retrieving from the database at the remote terminal the relevant textual trade data for the one of the objects associated with the selected one of the unique identifying indicia." This description is indefinite because it is internally inconsistent. It describes a database and remote terminal that communicate with each other through a host computer, but later in the same claims it locates the database at the remote terminal.

Claims 6 and 8 have been amended to correct the cited internal inconsistency. Claim 6 has been amended to recite in part "retrieving from the database for viewing at the remote terminal the relevant textual trade data for the object associated with the unique identifying indicia". Claim 8 has been amended to recite in part "retrieving from the database for viewing at the remote terminal the stored image for the object associated with the unique identifying indicia". Accordingly, the rejection is moot, and Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, second paragraph.

The Examiner rejected Claims 1-16 and 59-78 under 35 U.S.C. §103(a) as being unpatentable over Paskowitz (U.S. Pat. No. 6,377,937) in view of Mayer et al. (U.S. Pat. No. 5,042,650). The Examiner stated:

Paskowitz teaches a method and system for grading and commoditizing objects, making them trade ready. Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs. 1-6, column 3 lines 20-30, column 6 lines 32-58). Paskowitz teaches commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object (see at least abstract, figs. 3, 5; column 1 lines 16-34, column 6 lines 32-58, column 8 lines 32-47, line 65 – column 9 line9). Paskowitz teaches these steps for a plurality of objects and providing access to the relevant textual trade data in the database to sellers to generate trade listings for the objects (see at least abstract, column 6 lines 32-58).

Applicant respectfully traverses the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success wherein such an expectation of success is formulated upon art known to be available at the time applicant's claimed invention was reduced to practice. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Finally, the prior art references when combined must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent Claims 1, 59, 70, and 75 of the instant application recite in various forms at least the steps of grading an object and generating a grade indicator, associating the grade indicator with the object in a substantially permanent manner, and commoditizing the object.

Initially, it must be understood that Paskowitz discloses a data retrieval method that is buyer centric. The data retrieval method generally relates to retrieving information from electronic files where prospective buyers attempt to access information residing within a computer network environment in pursuit of desired products and services. A taxonomy of products and services is defined and a companion data dictionary of predetermined characteristics is linked to electronic files including descriptive terms representing a plurality of products or services. In use, a prospective buyer having access to the search and retrieval capability disclosed by Paskowitz selects required characteristics from the taxonomy, uses the selected characteristics to query a commerce information system, and awaits the results of a database search. A resultant display presented to the prospective buyer identifies products and/or services that may be of interest to the prospective buyer.

Applicant respectfully submits that Paskowitz fails to disclose grading an object for the purpose of ascertaining the relative condition of the object. Paskowitz does not disclose the step of ascertaining the grade or condition of an object. Paskowitz fails to mention or place any significance whatsoever on the art of grading objects. Nowhere within the cited reference is it shown or suggested that Paskowitz is cognizant of any commercial importance associated with establishing a grade characteristic for a unique tangible object where its value is dependent upon grade. Furthermore, nowhere within the cited reference does Paskowitz disclose that a user will physically interact with a tangible object while querying the commerce system. It is well known

in the art that grading objects such as coins, stamps, sports cards and the like, for example, requires close physical proximity and hands-on visual inspection. Certainly, the art of encapsulation requires physical contact and control over the object. There is no evidence whatsoever that the commerce system specified by Paskowitz facilitates physical contact with tangible products. There is no teaching or suggestion in Paskowitz for grading an object based upon a predetermined grading scale. A careful reading of Paskowitz reveals that significant steps recited in Applicant's claims are clearly absent from the disclosure of Paskowitz.

Paskowitz also fails to disclose commoditizing objects. In reference to independent Claim 1 of the instant application, the cited prior art fails to disclose storing relevant trade data such as a grade indicator in a database in a form for use in generating a trade listing for an object. Applicant is entitled to serve as his own lexicographer, and in doing so Applicant's disclosure defines the term "commoditizing" as it relates to collectible objects such as rare coins, sports trading cards, stamps, currency and the like. Applicant's specification from page 43, line 16 through page 44 line 17 discloses (underlining added):

The steps of a method wherein an auction facility (e.g. eBay™) purposefully captures or otherwise stores a raw or encapsulated indicator, a grade indicator and/or an applicable grading firm identity shall each constitute an embodiment of the present invention. Correspondingly, it will be recognized and appreciated by those skilled in the art that an independent auction listing tool, a third party data repository or alternative third party Web site may enable a user (seller) to generate an online auction instance (auction-style listing) on behalf of the auction facility (e.g. eBay™) and in doing so, the means for gathering the at least relevant grade indicator and applicable grading firm identity would be implemented in an equivalent circumventing manner as suggested by the present teachings. It is to be understood that such independent auction listing tools and/or third party Web sites as disclosed herein are heretofore unknown in the art. Therefore, the practice of gathering the at least relevant raw indicator, encapsulated indicator, grade indicator and/or applicable grading firm identity utilizing an independent auction listing tool, third party data repository or third party auction enabling Web site shall constitute alternative embodiments of the present invention. As a practical consideration, third party grading firms could provide the marketplace with graded encapsulated objects that are conspicuously marked "marketplace-ready", "auction-ready" or "eBay™-marketplace-ready" or any meaningful variation thereof, for example. Accordingly, graded encapsulated objects being conspicuously marked or inscribed in such a manner may be exchanged in the marketplace utilizing auction facilities (e.g. eBay™) willing to receive the aforementioned at least "relevant trade data" already assigned and associated with each unique graded encapsulated object. Additional metadata (e.g. high resolution images, etc.) may also be included or otherwise made available in a predetermined manner. Streamlining the operation of online auction Web sites and facilitating the exchange of encapsulated graded objects in this way improves transactional efficiency within the marketplace and is therefore preferred. Accordingly, graded encapsulated objects possessing already assigned and associated characteristics including relevant trade data thereby making such objects "marketplace-ready" shall constitute an alternative embodiment of the present invention. Using the present inventor's own lexicon, this present teaching shall be defined as "commoditizing" graded encapsulated objects thereby facilitating the exchange of such objects. Commoditizing graded encapsulated objects provides the marketplace with a highly efficient streamlined trading means.

In view of Applicant's disclosure, Applicant respectfully disagrees that Paskowitz teaches "commoditizing" the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object. In order to commoditize encapsulated graded objects, a grade indicator and a grading firm identifier are established, the grade indicator is stored in a database, and the grade indicator is later made available to sellers for the purpose of generating a trade listing in a streamlined manner. Applicant submits that the Paskowitz system is a completely buyer driven search methodology offering no suggestion or teaching whatsoever whereby a seller can generate a trade listing. Ultimately, Paskowitz fails to disclose grading objects. Therefore, it follows that Paskowitz fails to disclose the requisite steps for commoditizing graded encapsulated objects as defined in Applicant's disclosed subject matter and claimed by Applicant.

Paskowitz actually teaches away from the concept that sellers (as users) can effectively interact with the information system for the purpose of marketing products directly to prospective buyers. Accordingly, Paskowitz makes data sourcing the sole responsibility of the so-called System Manager. Paskowitz fails to make any provision whatsoever whereby a seller acting unilaterally can gain access to stored relevant trade data and list a product or a service for sale by posting a trade listing. Any suggestion that Paskowitz teaches trade listing generation by sellers is completely unsupported by the cited reference. Applicant submits that Paskowitz fails to disclose the requisite steps of a method whereby sellers are provided with access to relevant trade data to generate trade listings for graded encapsulated objects.

The Examiner further stated that Paskowitz teaches

a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of trading in valuable objects that communicates data concerning the objects between buyers and sellers.

Applicant respectfully disagrees. In order for this to be possible, Paskowitz must teach that the commerce system also acts as an independent third party grading service wherein raw collectible objects are physically handled, visually examined and graded by experts prior to encapsulation. Furthermore, the facility disclosed by Paskowitz would have to assign unique identifying indicia to each object and physically associate the unique assigned identifying indicia with the object in a substantially permanent manner.

The present commercial success enjoyed by third party grading firms can be attributed to at least three important aspects. First, the practice of third party grading is considered to be market independent, wherein the graded objects are never directly traded by the grading firm or its personnel. In order to be considered unbiased (and therefore credible), grading firms refrain from trading in the objects that they grade. Second, critical aspects of the grading procedure are generated solely by the grading firm. In order to prove useful to the marketplace at large, the assignment of unique identifying indicia and the assignment of an object's grade are understood to have been generated by the grading firm. These critical aspects combined with encapsulation form the essential practices of the art. Third, there must be a substantially permanent and preferably tamper-evident association between the object and relevant trade data associated with the object. With respect to the art of third party grading and encapsulation, no other configuration of the above listed critical activities is known to exist. The success of third party grading is attributable in large part to the fact that the grading firms themselves are the preferred data generators relating encapsulated graded objects. Consequently, third party grading firms are viewed as the only logical repository for stored data associated with objects having been graded and encapsulated by the firm.

Nowhere can it be shown or suggested that the commerce system disclosed by Paskowitz serves as a product grading and encapsulation facility. Paskowitz does not disclose the elements of the claimed invention. To suggest that Paskowitz teaches "a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of trading in valuable objects that communicates data concerning the objects between buyers and sellers" is not only unsupported by the reference, it is an insufficient recitation of the Applicant's claimed subject matter. With respect to the art of third party grading, the disclosures attributed to Paskowitz offer no reasonable expectation for success. More accurately, in order for Paskowitz to serve as an adequate prior art reference, Paskowitz must teach "grading an object based upon a predetermined grading scale and generating a grade indicator for the object; b) associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder; and c) commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the

object. Applicant respectfully submits that Paskowitz does not disclose the above listed-features recited in the claims. Absent impermissible hindsight, there is no teaching or remote suggestion of a method for grading, encapsulating, and commoditizing objects making the objects trade ready as recited in the claims.

The Examiner further stated that:

Paskowitz however does not disclose encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder.

Mayer teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of trading in valuable objects that communicates data concerning the objects between buyers and sellers.

Mayer et al. does not teach a trading method as claimed by Applicant for storing relevant trade data in a database in a form for use in generating a trade listing. Applicant respectfully submits that Mayer et al. fails to teach any trading method whatsoever. A careful reading of Mayer et al. reveals only the slightest suggestion that a certificate of authenticity sealed in a tamperproof coin case offers marketplace utility. Furthermore, Applicant respectfully submits that Mayer et al. fails to disclose that a certificate of authenticity carries an associated grade or assigned unique identifying indicia. Mayer et al. makes no mention that relevant trade data associated with an encapsulated coin or associated with information carried upon a certificate of authenticity is maintained by the grading firm in a form other than being printed upon the certificate of authenticity. Clearly, Mayer et al. fails to disclose storing a grade indicator or an assigned unique identifying indicia in a database. Accordingly, Mayer et al. fails to teach a trading method because Mayer et al. fails to teach “commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object.” Furthermore, Mayer et al. fails to disclose any means by which relevant trade data such as images of coins or coin descriptions can be stored and/or retrieved.

Applicant submits that both alone and in combination of Paskowitz and Mayer et al. fail to disclose Applicant’s invention as recited in Claims 1-16 and 59-80. Accordingly, Applicant further submits that the Examiner does not make a viable argument that the Paskowitz and Mayer

et al. references when combined, teach or suggest all the claim elements, as required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, there is no suggestion or motivation whatsoever to combine the Paskowitz and Mayer et al. references. The Examiner must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Examiner has not provided objective evidence for a suggestion or motivation to combine the references.

Claims 2-16 and 79-80, 60-69, 71-74, and 76-78 respectively depend, directly or indirectly, from independent claims 1, 59, 70, and 75 and are patentable over Paskowitz in view of Mayer et al. for the reasons argued above.

Applicant respectfully submits that a *prima facie* case of obviousness has not been made for at least the above reasons. Accordingly, Applicant respectfully submits that Claims 1-16 and 59-80 are not obvious under 35 U.S.C. § 103(a), and are patentable.

The Examiner's favorable reconsideration of the rejections based upon 35 U.S.C. §103(a) is respectfully requested.

It is submitted that the claims now properly define applicant's invention and distinguish the same from the prior art.

Reconsideration of the application, as amended, is respectfully requested. Accordingly, a formal Notice of Allowance is solicited.

While the applicant's attorney has made a sincere effort to properly define applicant's invention and to distinguish the same from the prior art, should the Examiner deem that other language would be more appropriate, it is requested that a telephone interview be had with the applicant's attorney in a sincere effort to expedite the prosecution of the application.